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EXAMINER	
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/580,305
Filing Date: May 26, 2000
Appellant(s): SHAH-NAZAROFF ET AL.

Justin B. Scout
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/5/2006 appealing from the Office action mailed 3/2/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The statement of the status of claims contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Carrubba et al. (U.S. Patent No. 5,629,866)

Hjelsvold et al. (U.S. Patent Publication Application 2003/0145333)

Wonfor et al. (U.S. Patent No. 6,381,747)

Ellis et al. (U.S. Patent No. 6,357,043)

Hendricks et al. (U.S. Patent No. 5,990,927)

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 2, 8-15, 18-21, 23, and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carrubba et al. (US 5,629,866) in further view of Hjelsvold et al. (US 2003/0145333 A1);

Claims 3-6 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carrubba et al. (US 5,629,866) in further view of Hjelsvold et al. (US 2003/0145333 A1), Wonfor et al. (US 6,381,747), and Ellis et al. (US 6,357,043 B1);

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carrubba et al. (US 5,629,866) in further view of Hjelsvold et al. (US 2003/0145333 A1) and Hendricks et al. (US 5,990,927).

(10) Response to Argument

Appellant argues that "Carrubba does not transmit the program: Program is housed on CD-I disc.., neither Carrubba nor Hjelsvold, either alone or in combination, suggests or describes receiving a selection to buy an upgraded media feature for a programming transmission" (Appeal Brief, pg. 11). The examiner respectfully disagrees. As discussed in the previous Advisory Action and Final Office Action, the Carrubba et al. reference discloses:

"[a]n embodiment for a system according to the invention is characterized in that the storage medium containing the basic part is located near the merging means and in that the other storage medium containing the complementary part is linked to the merging means via a transmission line of a communications network. The communications network is, for example, the public telephone network. The storage medium containing the complementary part is located, for example, in a data bank controlled by the provider. The complementary part stored in the databank is accessible to a plurality of users of a system according to the invention via the telephone network" (Carrubba 1:65-67; 2:1-9) wherein CPU controls the transmission of the media upgrade feature (Carrubba 4:21-32).

The claimed "programming transmission" is met by the combination of the complementary and basic part of the audio-visual presentation. The examiner respectfully submits that the transmission of the complementary part of the audio-visual presentation combined with the basic part of the audio-visual presentation results in programming that is, at least in part, transmitted and thus meets the claimed programming transmission. Thus the Carrubba et al. reference teaches a "programming transmission" comprising both a basic and complementary part.

It is also noted that the Carrubba et al. reference teaches "[w]ith the video-on-demand service, video film data are supplied to CD-I players on request. The databank may be controlled by a provider who provides the basic part free of charge or at a small amount on CD-I disc to the users" (Carrubba 4:36-40). It is submitted that the Carrubba et al. reference distinguishes between providing the basic part on a CD-I disc for a small amount or providing the basic part free of charge by a means distinguished from a CD-I disc.

However, assuming arguendo that the Carrubba et al. reference does not teach such a distinction. The examiner respectfully submits that the providing of the basic part free of charge by the provider inherently includes a form of transmission whether via a communication channel or through a physical storage medium. The Carrubba et al. reference discloses both forms of transmission. The transmission of the basic part via a physical storage medium, such as a CD-I disc, is discussed above. With regard to transmission of the basic part via a communication channel, the Carrubba et al. reference discloses "FIG. 11 shows a further embodiment for a system according to the invention. In this embodiment both the first storage medium, on which the basic part is stored, and the second storage medium, on which the complementary part is stored, are coupled to the merging means via the communications network. The storage media are found in different databanks 7', 7". These databanks may be controlled by the same provider who provides the basic part at a low rate and the complementary part at a higher rate" (Carrubba column 7, lines 13-21). It is noted that in this embodiment, Carrubba teaches both the basic part and complementary part are stored in databanks,

distinct from storage on a CD-I disc (compare column 4, lines 43-48 and column 7, lines 13-21). Thus the examiner respectfully submits that the further embodiment taught by the Carrubba et al. reference clearly teaches that both the basic part and the complementary part are transmitted, program transmissions.

With respect to Appellant's argument that "Carrubba does not transmit the program: Carrubba instead transmits 'upgraded media feature.'" The examiner respectfully disagrees for the same reasons as discussed above.

With respect to claims 3-6, 16, and 24, Appellant relies on the same assertion that Carrubba does not teach buying an upgraded media feature for a programming transmission. The examiner respectfully disagrees for the same reasons as discussed above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Jason Salce

10/10/2007

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